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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,958	09/05/2003	Jeannette Martello		7933

7590 07/05/2005
Terry M. Gernstein
1015 Salt Meadow Lane
McLean, VA 22101

EXAMINER

ROBERT, EDUARDO C

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/654,958

Applicant(s)

MARTELLO, JEANNETTE

Examiner

Eduardo C. Robert

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9,35-42,47 and 48 is/are pending in the application.
- 4a) Of the above claim(s) 1-9,35-40,42,47 and 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election of Invention I and Species III, i.e. Figures 5A-5B, (see restriction requirement mailed on 3/15/05) in the reply filed on April 1, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as **an election without traverse** (MPEP § 818.03(a)).

It is acknowledged applicant's believe that claims 1-9, 35-38, 41-42, and 47-48 read on the elected Species III, i.e. Figures 5A-5B. It is noted that comparison of the claims with Species III, i.e. Figures 5A-5B, and the specification shows, however, that the species of Figures 5A-5B does not have anchor holes oriented to cause lines through the center of the anchor holes to intersect the long axis, e.g. 92, of the anchor beyond the head, as required by claims 1-9. Actually, the anchor holes of the embodiment shown in Figures 5A-5B are oriented so that if lines extend through the anchor holes, the lines never will intersect the long axis. It appears that claims 1-9 are directed to the non-elected Species I, i.e. Figures 1-3, wherein in Figures 1 and 3 it is clearly shown that a line extending through the anchor holes will intersect the long axis at a point beyond the head. Furthermore, the species of Figures 5A-5B does not have passages having a chamfer at one end thereof as required in claims 35-38, 47 and 48. It is noted that as shown and described, these claims appear to be directed to non-elected Species I or II, wherein each includes passages having a chamfer at the ends. Also, the species of Figures 5A-5B does not have means on said anchor body for signaling when said anchor body is suitably fixed to the bone as required in claim 42.

Currently, claim 41 is a generic claim since it reads on all the species.

Art Unit: 3732

Claims 1-9, 35-40, 42, 47, and 48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim. Election was treated as an election made **without** traverse in the reply filed on April 1, 2005.

The requirement is therefore made FINAL.

Double Patenting

It is noted that claim 41 is a generic claim, meaning that is not directed to any specific Species and it is readable on all the Species. Thus, this claim clearly can be considered for double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 41 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,648,892. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the application claim and the patent claims lies in the fact that the patent claims include more elements and are thus much specific. Thus the invention of the patent claims

Art Unit: 3732

are in effect a “species” of the “generic” invention of the application claim. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claim is anticipated by the patent claims, it is not patentably distinct from the patent claims.

Claim 41 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-76 of U.S. Patent No. 6,168,598. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the application claim and the patent claims lies in the fact that the patent claims include more elements and are thus much specific. Thus the invention of the patent claims are in effect a “species” of the “generic” invention of the application claim. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claim is anticipated by the patent claims, it is not patentably distinct from the patent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 41 is rejected under 35 U.S.C. 102(b) as being anticipated by Stone et al. (U.S. Patent No. 5,443,482).

Stone et al. disclose a surgical anchor 10 comprising a threaded anchor body 12 having a long axis and an outer dimension. The anchor also includes a first end 16, which is adapted to

Art Unit: 3732

accommodate a tool (see Figure 3). The first end 16 has an outer dimension which is greater than the outer dimension of the anchor body 16 (see Figure 1). The anchor 10 further includes at least one suture-accommodating passage 18 defined in the first end. The passage has a portion near an end of the outer dimension. With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Stone et al. which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

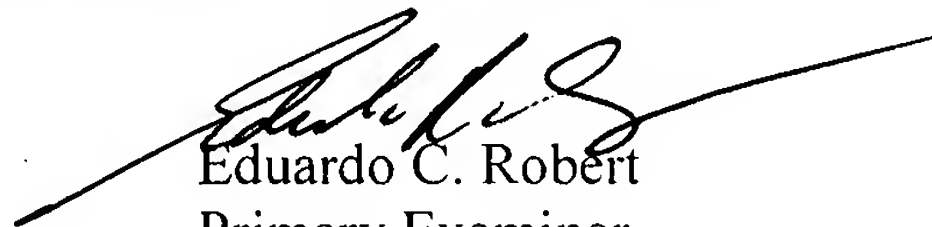
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 571-272-4719.

The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

Art Unit: 3732

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 571-273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C.R.